

## **REMARKS**

Applicant has received and carefully reviewed the Office Action mailed January 23, 2008. Currently, claims 1-15, 17-19 and 22-26 are pending, wherein claims 1-15, 17-19 and 23-26 have been rejected. Claims 4-6, 8 and 17 have been amended for clarity. No new matter has been added. Favorable consideration of the following remarks is respectfully requested.

### ***Drawings***

The drawings have been objected to under 37 CFR 1.83(a). The Examiner asserts that the “slots” must be shown or the feature(s) cancelled from the claim(s). The “slots” in the claims have been changed to “holes” which are shown in the drawings. Reconsideration and withdrawal of the objection is respectfully requested.

### ***Rejections under 35 U.S.C. § 112***

Claims 4-6, 8-10 and 17-19 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Examiner states, “It is unclear to the examiner as to whether there is a difference between a ‘slot’ and a ‘slit’.” The above claims have been amended such that the term slot has been changed to hole. As shown in the drawings, a slit is at the ends of the radiopaque marker whereas a hole is within the body of the radiopaque marker. Reconsideration and withdrawal of the rejection is respectfully requested.

### ***Rejections under 35 U.S.C. § 102***

Claims 1-2, 4-9, 11-15, 17-18 and 23-26 stand rejected under 35 U.S.C. §102(b) as being anticipated by Fischell et al. (US 5,484,425). Applicant respectfully traverses this rejection. MPEP 2131 states that, in order to anticipate a claim, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)."

Claim 1 recites a radiopaque marker band disposed over the tubular member, the marker band having an outer surface and an inner surface with one or more openings through the outer surface of the marker band. Fischell et al. at least fail to teach this limitation of claim 1. The Examiner asserts that Fischell et al. disclose “the marker band having multiple openings (slits of the coil) through the outer surface of the marker band.” However, one of ordinary skill in the art would not interpret the gaps between the windings of a coil to be equivalent to one or more

openings through the outer surface of the marker band. A gap between windings is not through anything let alone through a band. Further, there is no motivation or suggestion for one of ordinary skill in the art to modify the device of Fischell et al. to achieve the present invention.

For at least this reason, Applicant asserts Fischell et al. fail to anticipate claim 1. Claim 1 and the claims dependent thereon are believed patentable over the teachings of Fischell et al., and withdrawal of the rejection is respectfully requested.

Similar to claim 1, independent claim 11 recites the limitation of a radiopaque marker band disposed over the tubular member, the marker band having an outer surface and an inner surface with one or more openings through the outer surface of the marker band. For at least the reasons discussed above, Fischell et al. fail to disclose one or more openings through the outer surface of the marker band. Applicant asserts Fischell et al. fail to anticipate claim 11. Claim 11 is believed patentable over the teachings of Fischell et al., and withdrawal of the rejection is respectfully requested.

Independent claim 12 recites the limitation an elongate core member having a proximal end region and a distal end region and a radiopaque marker band disposed over the core member. Fischell et al. do not disclose the coil is disposed over a core member. Fischell et al. teach at column 3, lines 8-10, "a non-kinking, thin-walled sheath 10 is shown with an inner metal coil 12 that lies within a plastic covering." It is understood by one of ordinary skill in the art that a sheath is meant to cover something else. One of ordinary skill in the art would not interpret the coil of Fischell et al. to be disposed over a core member as this teaches away from the functionality of the device. Based on this distinction, Applicant respectfully submits that claim 12 and the claims dependent thereon are patentable over Fischell et al. Reconsideration and withdrawal of the rejection is respectfully requested.

Independent claim 17, as amended, recites the limitation a generally cylindrical body section having a first end surface, a second end surface and an annular wall extending from the first end surface to the second end surface, the body section having a first hole and a second hole defined therein. Fischell et al. do not disclose a body section having a first hole and a second hole therein. As discussed above with respect to claim 1, Fischell et al. disclose a helical coil wherein there is space between the turns of the winding. Fischell et al. do not disclose a hole through the "body section" of the coil. Further, there is no motivation or suggestion for one of ordinary skill in the art to modify the device of Fischell et al. to achieve the present invention.

Applicant respectfully submits that claim 17 and the claims dependent thereon are patentable over Fischell et al. Reconsideration and withdrawal of the rejection is respectfully requested.

Similar to claim 1, independent claim 23 recites the limitation a radiopaque marker band disposed over a portion of the inner tubular member at a selected location in the distal region, the radiopaque marker having an inner surface and an outer surface with at least one opening extending from the inner surface to the outer surface. For at least the reasons discussed above, Applicant respectfully submits that claim 23 and the claims dependent thereon are patentable over Fischell et al. Reconsideration and withdrawal of the rejection is respectfully requested.

***Rejections under 35 U.S.C. § 103***

Claims 3, 10 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fischell et al. Applicant respectfully traverses this rejection.

Claims 1 and 17, from which claims 3, 10 and 19 depend, are distinguished above as being patentable over Fischell et al. At least because they depend from one of claims 1 and 17 and add significant limitations to further distinguish them from the prior art, Applicant respectfully submits that claims 3, 10 and 19 are allowable over the cited reference. Reconsideration and withdrawal of the rejection is respectfully requested.

***Conclusion***

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

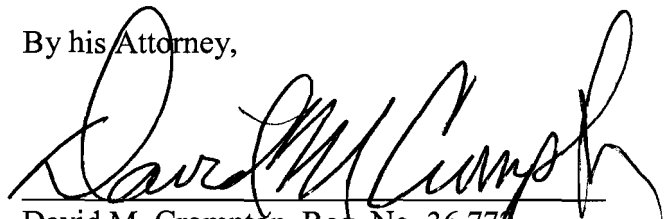
Respectfully submitted,

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By his Attorney,

Date: \_\_\_\_\_

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